

That the front-feed throat opening means is operated indirectly by the motor in appellee's construction is clear. In each cycle of operation of the machine the motor tightens the spring, storing its energy for use in the next cycle of operation of the machine.

We find nothing in said counts requiring the front-feed throat opening means to be operated directly by the motor, and we are not at liberty to read the word "directly" before the word "operable" in said counts.

Appellant contends that the reasoning applied in *Christian* applies here and that the count language in issue is met by rod 398 indirectly winding spring 365 during its clockwise movement.

At first glance, appellant's argument appears impressive; however, it overlooks the fact that the language involved here is narrower than that in *Christian* and specifically requires that the drive means operate in its *return stroke* to restore the actuator. At best, charging of spring 365 here can be characterized only as resulting in the drive means operating in its *forward stroke* to later permit restoration of the actuator.

We have considered fully all arguments of the parties; however, we think it apparent from the foregoing that Gubelmann has not discharged the burden which the law imposes on one in his position. Accordingly, the decision of the board is *affirmed*.

Court of Customs and Patent Appeals

In re CHITAYAT

No. 8125 Decided Apr. 3, 1969

PATENTS

1. Drawings—In general (§ 34.1)

Arguments based on mere measurement of patent drawings are of little value in absence of description in specification of relative dimensions.—In re *Chitayat* (CCPA) 161 USPQ 224.

Particular patents—Image Enhancement

Chitayat, Image Enhancement Means, claims 7 to 10 of application refused.—In re *Chitayat* (CCPA) 161 USPQ 224.

Appeal from Board of Appeals of the Patent Office.

Application for patent of Anwar K. Chitayat, Serial No. 266,730, filed Mar. 20, 1963; Patent Office Group 250. From decision rejecting claims 7 to 10, applicant appeals. Affirmed.

JOHN C. VASSIL (THOMAS P. DOWLING of counsel) both of New York, N. Y., for appellant.

JOSEPH SCHIMMEL (JERE W. SEARS of counsel) for Commissioner of Patents.

Before WORLEY, Chief Judge, and RICH, ALMOND, and BALDWIN, Associate Judges.

BALDWIN, Judge.

This appeal is from the Patent Office Board of Appeals decision affirming the rejection of all the claims of appellant's application¹ under 35 U.S.C. 103.

THE INVENTION

Appellant's invention relates to the field of fiber optics wherein optical images are transmitted along flexible bundles of light-transmitting fibers. Appellant acknowledges that it has previously been known to impart a cyclic displacement of the image relative to the fibers to ensure that all parts of the image are presented at one time or another to intact fibers for transmission along the bundle, thus avoiding degradation of the received image due to elements of the image being lost in the spaces between adjacent fibers or along broken fibers. Appellant's invention resides in providing a displacement of the image which amounts to at least one hundred fiber diameters to cause an alleged improvement in the quality of the transmitted image.

Claim 7, which is reproduced as follows, is typical of the claims on appeal, and the patentability of it is determinative of all issues in this appeal.

7. A coherent image transmitting system comprising an optical fibre bundle having physically separate variably oriented ends and transmission improving means for improving the effective resolution of the transmitted image and eliminating the effect of broken fibres independent of the relative orientation of said ends comprising image displacing means at each of said ends for imparting a displacement of the respective image, said displacing means being configured whereby the driving thereof causes elements of said image to be displaced

¹ Serial No. 266,730, filed March 20, 1963, for "Image Enhancement Means," allegedly a continuation-in-part of serial No. 116,179, filed June 9, 1961.

mistake or deception of purchasers is not likely to occur. (Italics supplied.)

[1] While we appreciate the "crinkled" nature of applicant's goods, we are unable to agree that that single factor is sufficient, in view of the other facts here, to preclude a likelihood of confusion within the meaning of Section 2(d) of the Lanham Act.

[2] Even if there were doubt on that score, we would feel obliged to resolve it in favor of the first user and against the newcomer. *Carlisle Shoe Co. v. Societe Anonyme: Roger Fare & Cie.*, 47 CCPA 966, 278 F.2d 519, 126 USPQ 54.

Under such circumstances, we must reverse the decision appealed from.

50 CCPA 827

Court of Custom and Patent Appeals

In re WILSON AND CORNS

Appl. No. 6862 Decided Jan. 16, 1963

PATENTS

1. Patentability—Invention—In general (§ 51.501)

Production of same end result is not determinative of obviousness of structure and does not support conclusion of unpatentability.

2. Words and phrases (§ 70.)

There is nothing inaccurate in use of "baffle" to indicate a means to "direct" flow of atmosphere since dictionary defines "baffle" as an artificial obstruction for deflecting flow of gases; also, if it were not for applicants' "baffle wall means," flow of gases as required by claim would not be possible; therefore, use of "direct" is not entirely inapposite and inaccurate.

3. Drawings—In general (§ 34.1)

Patent drawings are not working drawings.

4. Construction of specification and claims — Comparison with other claims (§ 22.40)

In view of applicants' repeated use of the conjunctive ("during and between") in certain claims, court is forced to conclude that their use of the disjunctive ("during or between") in other claims was intended to broaden scope of latter claims.

5. Patentability—Invention—In general (§ 51.501)

Inasmuch as limitation is not essential

to applicants' invention, it cannot serve patentably to distinguish their invention from references.

Particular patents—Annealing Metal

Wilson and Corns, Method of and Apparatus for Annealing Strip Metal, claim 21 of application allowed; claims 1 to 10, 12, 13, 20, and 22 refused.

Appeal from Board of Appeals of the Patent Office.

Application for patent of Lee Wilson and Edwin A. Corns, Serial No. 639,939, filed Feb. 13, 1957; Patent Office Division 19. From decision rejecting claims 1 to 10, 12, 13, and 20 to 22, applicants appeal. Affirmed as to claims 1 to 10, 12, 13, 20, and 22; reversed as to claim 21.

BOSWORTH, SESSIONS, HERRSTROM & KNOWLES and PAUL S. SESSIONS, both of Cleveland, Ohio (SPENCER B. MICHAEL, Washington, D.C., of counsel) for appellants.

CLARENCE W. MOORE (JOSEPH F. NAKAMURA of counsel) for Commissioner of Patents.

Before WORLEY, Chief Judge, and RICH, MARTIN, SMITH, and ALMOND, Associate Judges.

RICH, Judge.

This appeal is from the decision of the Patent Office Board of Appeals affirming the examiner's rejection of claims 1-10, 12, 13, and 20-22 in application Ser. No. 639,939, filed February 13, 1957, entitled "Method of and Apparatus for Annealing Strip Metal."

Claim 10 sets forth appellants' method comprehensively. We have divided it into its steps and added the bracketed letters. It reads:

10. The method of annealing strip metal which includes the steps of

[a] re-coiling an unannealed tightly wound coil of said strip metal into an opened coil by

[b] interwinding a spacer strand between the successive laps of the strip during said re-coiling whereby

[c] said laps are positively and substantially uniformly spaced apart by a distance substantially equal to the radial thickness of the spacer strand,¹

¹ For reasons which will appear, infra, we note that several of the method claims refer to the spacing of the laps in language similar to the following, from claim 2:

* * * the laps thereof [of the coil] substantially uniformly spaced apart a distance not less than about one-half the thickness of the strip and not more than about three times the thickness of the strip * * *.

factory annealing can be achieved even in the presence of "contact between a few laps of a given coil." Furthermore, we observe that appellants' supporting rack on which their coil rests has a number of spokes which would impede gas flow as much or more than the coil springs of Peterson. While Peterson also uses a rack, it has fewer spokes by far than appellants' rack.

Appellants also allege that the "specifically defined" lap spacing recited in claims 2, 4, 6, 8 and 20 patentably distinguishes these claims over the references.⁷ The essence of appellants' argument is set forth in their brief as follows:

Thus, because turbulent flow conditions exist in the spaces between the laps when the gap becomes wider than about three times the strip thickness (R. 51), which turbulent flow conditions greatly reduce the heat transfer rate as compared to laminar flow which occurs below three times the strip thickness, it is "critical" that the space be maintained below about three times strip thickness. If the gap is less than about one-half the strip thickness the maximum available pressure of the circulating atmosphere at the end of the coil will not move sufficient gas through the coil to produce the tremendously improved results that are obtained by the claimed procedure.

As to this limitation also, however, we do not think the record supports its alleged "criticality." At first blush the "critical" nature of a "less than about" limitation seems doubtful. Appellants' specification is of no help in this regard when it states:

The most effective and economical lap spacing varies to a degree with the thickness and width of the strip of the coil being treated. Thus, for a given strip width, with relatively thin strip (for example from .008" to .02" [sic] in thickness) the width of the space or passage between the laps may be less, relative to the strip thickness, than with coils of relatively thick strip (such as .006" to .015"). The width of the strip of the coil also has an influence on the most desirable space between laps of the opened coil and, generally speaking, the wider the strip the greater should be the spacing between laps. [Emphasis ours.]

[3] Both the Patent Office and appellants have engaged in what appears to us to be a somewhat futile attempt to measure the thickness of Weisse coil strip and the Weisse lap spacing in their

respective attempts to show whether the particular lap spacing recitations included in the claims now before us are or are not distinguishable from those disclosed by Weisse. Appellants, for example, conclude, in typically precise fashion, that the Weisse lap spacing is "about 30% to 60% greater than applicants' top spacing." Patent drawings are not working drawings and this argument is predicated, moreover, on a greatly enlarged section of a small drawing obviously never intended to show the dimensions of anything. We do not find it persuasive.

Appellants have alleged "tremendously improved" and "extraordinary results" to be attributable to the particular lap spacing recited. We find no statement in the record which even alleges results improved in any degree over the results obtainable by annealing a sheet metal coil *configured in the form disclosed by either Weisse or Peterson*. The "tremendously improved results" alleged by appellants exist only on comparison of their method with results achieved by the prior art method of annealing *tightly wound* coils. But the prior art relied on here discloses open or spaced coils. Accordingly, we find appellants' recited lap spacing not critical because (1) in view of the vague terminology used in the claims the disclosure of Weisse, for example, is sufficiently suggestive of the *claimed* lap spacing, and (2) the alleged improved results have not been shown with reference to either the Weisse or Peterson disclosures. The open coils of these references would have the same rapid heat transfer advantages possessed by appellants' open coils.

One final point remains to be discussed—It relates to the "substantially vertically disposed" limitation [i] of claim 10 which appears in various forms in method claims 2 through 10, 12, and 13.⁸ We find appellants' arguments concerning this limitation related to their previously discussed "completely unimpeded" limitation. Appellants, referring to their "non-inversion step" as they call limitation [i], state that this limitation is "essential" in their method. Further, they state:

* * * that applicants' vertical axis

[4] ⁸ In view of appellants' repeated use of the conjunctive in claims 2-10, 12 and 13 (e.g., "during and between the steps set forth"), we are forced to conclude that their use of the disjunctive in claims 1, 20 and 22 (e.g., "during or between the steps set forth") was intended to broaden the scope of the latter claims. Accordingly, we have not considered appellants' arguments relative to limitation [i] applicable to the latter claims.

⁷ See note 1, supra.

41 C.C.P.A. (Patents) 871

Court of Customs and Patent Appeals

In re OLSON

Appl. No. 6045 Decided Mar. 23, 1954
 Rehearing denied May 24, 1954

PATENTS

1. Amendments to patent application—
 New matter (§ 13.5)
 Amendments to patent application—
 Specification (§ 13.7)
 Drawings—Disclosure in drawings
 only (§ 34.3)
 Oath (§ 47.)

Although 35 U.S.C. 132 provides that no amendment to application shall introduce new matter into disclosure of invention, it is proper, in support of claims which otherwise could not be allowed, to amend specification to include new matter clearly and conclusively disclosed by drawings; however, where drawings fail to meet that requirement, Patent Office will not receive supplemental oath for purpose of curing defects in drawings or establishing facts which specification should have recited when it was originally filed as part of application.

2. Drawings—In general (§ 34.1)

Ordinarily, drawings which accompany application are merely illustrative of principles embodied in alleged invention claimed therein and do not define precise proportions of elements relied upon to endow claims with patentability.

3. Drawings—In general (§ 34.1)

Drawings—Disclosure in drawings only (§ 34.3)

It is well known that Patent Office drawings are not normally drawn to scale; therefore, where dimensions involved are of the order of a few thousandths of an inch, it is obvious that drawing alone cannot be scaled off to show that any particular distances or sizes are exactly equal when specification is silent in this respect.

4. Claims—Specification must support (§ 20.85)

Patent grant—In general (§ 50.01)

Specification—Sufficiency of disclosure (§ 62.7)

Under 35 U.S.C. 112, claims shall be allowed solely on condition that applicant submits in his specification a written description of invention in such full, clear, and exact terms as to enable any person skilled in art to make, construct, and use the same: by compliance with

this requirement, progress of science and useful arts will be promoted; this is particularly effective following expiration of patent monopoly when subject thereof reverts to public domain.

5. Patent grant—Intent of patent laws (§ 50.15)

Statutes make reward to inventor and owner of patent a matter of secondary consideration; nevertheless, Congress intended, during life of patent, that its owner shall be endowed by such statutes with valuable, enforceable rights, together with commensurate rewards, on theory that encouragement of individual effort by personal gain is best way to advance public welfare.

Particular patents—Coupler

Olson, Coupler for Fluid Lines, claims 24 to 27 of application refused.

Appeal from Board of Appeals of the Patent Office.

Application for patent of Elmer T. Olson, Serial No. 103,577; Patent Office Division 52. From decision rejecting claims 24 to 27, applicant appeals. Affirmed; Worley, Judge, dissenting without opinion.

ANDREW E. CARLSEN, Minneapolis, Minn., for appellant.

E. L. REYNOLDS (H. S. MILLER of counsel) for Commissioner of Patents.

Before O'CONNELL, JOHNSON, WORLEY, COLE and JACKSON (retired), Associate Judges.

O'CONNELL, Judge.

This is an appeal from the decision of the Board of Appeals of the United States Patent Office sustaining the action of the Primary Examiner in rejecting claims 24 to 27, inclusive, of appellant's application for a patent on alleged improvements in couplers for hydraulic hose lines and the like. No claims were allowed.

The cited references are:

Tessner 1,114,937 Oct. 27, 1914
 Mitton 1,721,349 July 16, 1929
 Smith et al. 2,307,427 Jan. 5, 1943
 Frank 2,313,223 Mar. 9, 1943
 Johnson et al. 2,322,449 June 22, 1943
 Ulrich 2,533,640 Dec. 12, 1950

Claim 24 is illustrative and reads as follows:

24. A coupler for releasably connecting hydraulic fluid conduits comprising, a pair of disconnectable body members having tubular bores extending longi-

BEST AVAILABLE COPY

tudinally therethrough and disposed end to end with the bores in communicating alignment, means carried by and releasably connecting the adjacent end portions of the body members to retain them in fixed alignment and seal them against the escape of fluid from between the communicating ends of the bores, the adjacent ends of the bores each having a valve seat of lesser diameter than the bore, a pair of valve balls disposed one in each of the bores adjacent the respective seats for projecting therethrough and closing there against to prevent the escape of fluid from the conduits when the body members are disconnected, said valve balls being operative by contact pressure between their projected portions, when the body members are being connected, to unseat each other from their respective valve seats, springs urging the balls toward the respective valve seats, a pair of ball stop members having threaded base portions screwed into the outer end portions of the respective bores so as to be rigidly stationary therein, a stem portion extending rigidly inwardly from each of the base portions, and a head portion integral with each of the inner ends of the stem portions, said base portions having fluid passageways in substantial alignment with annular fluid passageway defined by the inner surfaces of the bores and outer surfaces of the said balls, head portions and stem portions, *said ball stop head portions being equally spaced with respect to their associated valve seats to receive the balls when they are unseated from their valves by connecting the body members*, and said ball stop heads also being terminally recessed to center the balls with respect to the valve seats when the body members are connected and the valve balls are in full valve opening position. [Italics supplied.]

The claims were all disallowed, among other reasons, on the ground that they were unpatentable over the art of record. The main ground of rejection, however, in this case resides in the concurring decisions of the tribunals of the Patent Office to the effect that the limitation relating to the ball centering means being equally spaced from the valve seats, recited in each of the respective claims, is new matter, not presented in the original specification, and not clearly shown in the drawing. The primary issue was thus summarized and approved by the board to the following effect:

Claims 24 through 27 stand rejected as being directed to new matter. It is the Examiner's position that these

claims all include the following: "said ball stop head portions being equally spaced with respect to their associated valve seats to receive the balls when they are unseated from their valves by connecting the body members," which appears in lines 29 to 32 of claim 24, or equivalent language therein, and that there is no basis for such a recitation anywhere in the original disclosure.

Appellant states that this structure is supported by his original drawing and has filed an oath under the provisions of Rule 67, in order to support his contention and has also amended the specification to include this subject matter. His contention is that the drawing constitutes a disclosure of the subject matter and that under prevailing decisions, he is entitled to amend the specification in accordance with the disclosure of the drawing to support his position.

[1] The patent laws provide that in the prosecution of an application for a patent, no amendment shall introduce new matter into the disclosure of the invention. 35 U.S.C. (1952) § 132. The board correctly held, however, that it is proper in support of claims which otherwise could not be allowed, to amend the specification of a pending application to include new matter clearly and conclusively disclosed by the drawings. *Bloodhart v. Levernier*, 20 C.C.P.A. (Patents) 917, 64 F.2d 367, 17 USPQ 188; *Wiemer v. Coe*, Comr. Pats., 45 USPQ 407.

Where the drawings fail to meet that requirement, the Patent Office will not receive an affidavit, such as was submitted in the case at bar, for the purpose of curing defects in the drawings or establishing facts which the specification should have recited when it was originally filed as part of appellant's application. *In re Smyth*, 38 C.C.P.A. (Patents) 1130, 189 F.2d 982, 90 USPQ 106.

[2] Ordinarily drawings which accompany an application for a patent are merely illustrative of the principles embodied in the alleged invention claimed therein and do not define the precise proportions of elements relied upon to endow the claims with patentability. *In re Kinderman*, 37 C.C.P.A. (Patents) 800, 178 F.2d 937, 84 USPQ 242. See also *In re Betz*, 35 C.C.P.A. (Patents) 1033, 166 F.2d 831, 77 USPQ 162; *Wasberg v. Ditchfield*, 33 C.C.P.A. (Patents) 1099, 155 F.2d 408, 69 USPQ 538. Accordingly, the board in refusing to accept appellant's affidavit and the proposed amendments of his specification properly held:

[3] The statement as to the particular spatial relationship between the

is not given any of the presumptions of section 7(b) of the Act. These include "ownership of the mark," and ownership "imparts prima facie evidence of use." *J.C. Hall Co. v. Hallmark Cards, Inc.*, 52 CCPA 981, 984, 340 F.2d 960, 962, 144 USPQ 435, 437 (1965). Accord, *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402, 181 USPQ 272, 274 (CCPA 1974). Accordingly, the owner of a mark on the Supplemental Register would have to affirmatively prove use of that mark. See *Aloe Creme Laboratories, Inc. v. Bonne Bell, Inc.*, 168 USPQ 246 (TTAB 1970). This contrasts with the presumption of continuing use of a mark by the owner of a registration on the Principal Register. *Gillette Co. v. Kempel*, 45 CCPA 920, 921-22, 254 F.2d 402, 404, 117 USPQ 356, 357 (1958).

Court of Customs and Patent Appeals

In re Marshall

No. 77-625 Decided June 30, 1978

PATENTS

1. Patentability — Anticipation — In general (§51.201)

Patentability — Anticipation — Combining references (§51.205)

Rejections under 35 U.S.C. 102 are proper only when claimed subject matter is identically disclosed or described in prior art; in other words, all material elements recited in claim must be found in one unit of prior art to constitute anticipation; In re Samour, 197 USPQ 1, did not disturb this principle.

2. Patentability — Anticipation — In general (§51.201)

Accidental or unwitting duplication of invention cannot constitute anticipation.

3. Patentability — Evidence of — Suggestions of prior art (§51.469)

Patentability — New use or function — In general (§51.551)

Drug's known disadvantages that would naturally discourage search for new uses of that drug may be taken into account in determining obviousness.

Particular patents — Weight Reduction

Marshall, Process for Weight Reduction, rejections of claims 1-9 reversed.

Appeal from Patent and Trademark Office Board of Appeals.

Application for patent of Edward M. Marshall, Serial No. 468,552, filed May 9, 1974. From decision rejecting claims 1-9, applicant appeals. Reversed; Markey, Chief Judge, with whom Baldwin, Judge, joins, dissenting in part, with opinion.

Edward D. O'Brian, Anaheim, Calif., for appellant.

Joseph F. Nakamura (Jack E. Armore, of counsel) for Commissioner of Patents and Trademarks.

Before Markey, Chief Judge, and Rich, Baldwin, Lane, and Miller, Associate Judges.
Lane, Judge.

This is an appeal from the decision of the Patent and Trademark Office (PTO) Board of Appeals (board) sustaining the examiner's rejection under 35 USC 102 of claims 1-4 and entering a new ground of rejection under 37 CFR 1.196(b) of claims 5-9 under 35 USC 103. We reverse both rejections.

Background

Invention

Normally, when food passes through the terminal region of the stomach, nerve endings there stimulate the release of two hormones, secretin and pancreozymin. These hormones then trigger the production and release of pancreatic enzymes necessary for digestion in the small intestine.

Applicant's weight control process involves anesthetizing these nerve endings with an orally administered anesthetic containing 50-2,000 mg of oxethazaine. This prevents the release of secretin and pancreozymin which in turn interferes with the production and release of the pancreatic enzymes. Thus, food passing through the small intestine is not digested and does not contribute calories to the body.

The following claims are before us on appeal:

1. In a weight control process in which a quantity of food is consumed

BEST AVAILABLE COPY

cation of this local anesthetic inhibits the release of the acid-stimulating hormone, gastrin.

Slayback is an article reporting an investigation into the mechanism responsible for the release of the pancreatic secretory hormones, secretin and pancreozymin. Researchers found that application of the anesthetic oxethazaine HCl to isolated segments of the small intestine of surgically altered dogs caused a substantial reduction in the release of both secretin and pancreozymin. These results were consistent with the hypothesis that secretin and pancreozymin release is controlled by a local neural mechanism similar to the one which had been shown to control the release of the gastric secretory hormone, gastrin.

Proceedings Below

The examiner rejected claims 1-4 under 35 USC 102 as anticipated by the PDR and also rejected claims 1-9 under 35 USC 102/103 as anticipated or obvious over a patent to Pober.¹ The board affirmed the 102 rejection of claims 1-4 but reversed the 102/103 rejection of claims 1-9 and entered a new ground of rejection under 37 CFR 1.196(b) rejecting claims 5-9 under 35 USC 103 as obvious in view of the combined teachings of PDR and Slayback.²

Opinion

102 Rejection

[1] Rejections under 35 USC 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. In re Arkley, 59 CCPA 804, 807, 455 F.2d 586, 587, 172 USPQ 524, 526 (1972). In other words, to constitute an anticipation, all material elements recited in a claim must be found in one unit of prior art. Soundsciber Corp. v. United States, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct.Cl. 1966). This basic principle of patent law has not been disturbed by our recent decision, In re Samour, 571 F.2d 559, 197 USPQ 1 (CCPA 1978), in which we affirmed a §102(b) rejection of claims

to a chemical compound based on a primary reference which disclosed the compound and additional references which established that a method of preparing the compound would have been obvious to one skilled in the art. In Samour, every material element of the claimed subject matter, the chemical compound, could be found in the primary reference, a disclosure of that compound.

[2] Applying this rule of law to the present case, we must reverse the board's rejection of claims 1-4 under 35 USC 102 since the primary reference, the PDR, does not disclose every material element of the claimed subject matter. These claims are directed to a weight control process. Applicant uses an effective amount of the anesthetic, oxethazaine, to inhibit release of the pancreatic secretory hormones, secretin and pancreozymin, in order to control weight. The PDR, however, teaches using drugs containing the anesthetic oxethazaine to inhibit release of the acid-stimulating hormone, gastrin, in order to treat esophagitis, gastritis, peptic ulcer and irritable colon syndrome. Nothing in the PDR remotely suggests taking oxethazaine to lose weight. If anyone ever lost weight by following the PDR teachings it was an unrecognized accident. An accidental or unwitting duplication of an invention cannot constitute an anticipation. In re Felton, 484 F.2d 495, 500, 179 USPQ 295, 298 (CCPA 1973).

103 Rejection

The board seems to have combined: (1) the teaching of the PDR that oral administration of oxethazaine inhibits release of gastrin, (2) the teaching of Slayback that secretin and pancreozymin release is controlled by a local neural mechanism similar to the one which controls release of gastrin, and (3) the art-recognized fact that secretin and pancreozymin control the production and release of pancreatic enzymes necessary for digestion in the small intestine, to conclude that applicant's method of controlling weight by anesthetizing the nerve endings that stimulate the release of secretin and pancreozymin would have been obvious.

The problem with this rejection is that nowhere in any reference is there any suggestion to control weight by turning off the production and release of pancreatic enzymes. Although it has long been known that pancreatic enzymes are involved in digestion, from this record it appears that

¹ U.S. patent No. 3,740,440, issued June 19, 1973, for "Method of Inhibiting Appetite for Food."

² The board does not explain why this new ground of rejection was not applied to claims 1-4 as well.